

REMARKS

Applicant is pleased for the withdrawal of the prior rejections under 35 USC 112. Claim 47 has been canceled to avoid duplication of claim 46, in accordance with the Examiner's comments.

Claims 32-35 and 37 have been rejected under 35 USC 112. The Examiner notes that the definition of "functional discomfort reliever" (a phrase recited in claim 32) may not be clear. Claim 32 has been canceled. Amendment of claim 33 is presented to clarify antecedent basis by changing "container" to --closure--. Applicant authorizes the Examiner to cancel claim 33 if it is considered to be indefinite. Claims 34, 35 and 37 are believed to comply with the requirements of 35 USC 112.

Claims 26-30, 32-35 and 37-47 have been rejected under 35 USC 103 as being unpatentable over SS Pharmaceutical in view of Tsunoda, Yeh et al and Lambelet. The Examiner notes that the instant method claims enclose agents. The agents taught to be enclosed by SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet are not disclosed as providing supplements for nutrition or a percent of a recommended daily value for a nutritional supplement. Applicant's invention provides supplements for nutrition and an indication of a percent of a recommended daily amount (or value) for each nutritional supplement. The nutritional supplements in Applicant's claimed method are in addition to any agents in the unit dose of orally consumable material, which are adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever. Vitamin C and B1 in SS Pharmaceutical are disclosed as part of a cold medicine and painkiller, which also contains ibuprofen, as see lines 2-3 of the abstract. Thus, vitamin C and B1 in the cold medicine and painkiller of SS Pharmaceutical are disclosed as being adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever. So, vitamin C and B1 in the cold medicine and painkiller of

SS Pharmaceutical are not within the group of nutritional supplements in Applicant's claimed method.

Similarly, Vitamin C in Tsunoda is disclosed as part of a pain medicine, which also contains ibuprofen, as see first paragraph. Thus, vitamin C in the pain medicine of Tsunoda is disclosed as being adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever. The nutritional supplements in Applicant's claimed method are in addition to and do not include any agents in the unit dose of orally consumable material, which are adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever. So, vitamin C in the pain medicine of Tsunoda is not within the group of nutritional supplements in Applicant's claimed method.

Yeh et al disclose medicine for periodontal disease (see column 1, lines 6-7 and column 2, lines 1-12). Periodontal disease is not a discomfort, and medicine for periodontal disease is not a discomfort reliever. "Discomfort" is defined at page 4 in the above captioned patent application, to refer to discomfort from at least one of: minor aches and pain associated with a common cold, headache, toothache, backache, muscular aches, menstrual cramps, minor pain of arthritis, fever, running nose, sneezing, itching of nose or throat, itchy watering eyes due to hay fever or other upper respiratory allergy, insomnia (difficulty in falling asleep), sleepiness, fatigue and drowsiness. Thus, discomfort as used in the above captioned patent application is limited to the indications specified in its definition. These specified indications do not include periodontal disease of Yeh et al. "Discomfort reliever" as used in the above captioned patent application, is defined at page 4 to refer to predetermined pharmaceutically effective amounts of orally consumable material adapted for temporary relief of at least one discomfort. Thus, discomfort reliever, as used in the above captioned patent application, is limited to material adapted for temporary relief of at least one specified indication in the definition of discomfort. These specified indications do not include periodontal disease. So, Yeh et al do not disclose a discomfort, or a discomfort reliever.

Lambelet discloses a pharmaceutical container, as see column 2, lines 15-40. Applicant's invention provides supplements for nutrition, an indication of a percent of a recommended daily value (or amount) for each nutritional supplement and discomfort reliever. Lambelet does not disclose supplementing nutrition, a nutritional supplement, indicating a percent of a recommended daily value (or amount) of a nutritional supplement, a discomfort or a discomfort reliever.

Thus, neither SS Pharmaceutical, Tsunoda, Yeh et al nor Lambelet, disclose supplementing nutrition, indicating a percent of a recommended daily value (or amount) of a nutritional supplement, or providing a nutritional supplement, which is not adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever, as is required by the method claimed by Applicant. Accordingly, claims 26-30, 32-35 and 37-47 are not unpatentable over SS Pharmaceutical in view of Tsunoda, Yeh et al and Lambelet.

#### YEH ET AL IS NONANALOGOUS ART

Yeh et al fails to qualify as analogous art under the Deminiski criteria of whether the art is in the same field (relieving discomfort, as used in the above captioned patent application, and supplementing nutrition) and reasonably pertinent to the particular problem with which the inventor is involved, (indicating a discomfort reliever, as used in the above captioned patent application and indicating a daily amount of a nutritional supplement), In re Clay 23 USPQ 2d 1058, 1060 (1992, CAFC). Thus, Yeh et al is too remote to be treated as prior art, In re Sovish 769 F2d 738, 741; 226 USPQ 771, 773 (Fed.Cir., 1985). Yeh et al is directed to the field of medication for periodontal disease, see column 1, lines 6-7 and column 2, lines 1-12. Yeh et al disclose medication for periodontal disease and not for a discomfort or supplementing nutrition as claimed by Applicant. Thus, Yeh et al do not include disclosure in the field or disclosure pertinent to the problem with which Applicant is involved in the above captioned patent application. So, Yeh et al is not pertinent art, as Yeh et al is not part of the art to which the subject matter sought to be patented pertains Sovish. Thus, Yeh et al is too

remot to be treated as prior art. Accordingly, the rejection of claims 26-30, 32-35 and 37-47 as obvious over references in combination with Yeh et al is improper.

THE APPLIED REFERENCES DO NOT DISCLOSE THE FEATURES OF THE CLAIMED INVENTION OR ANY BENEFIT FROM THE USE THEREOF

The absence from the applied references of an explicit requirement of the claims makes the rejection improper, In re Evanega 4 USPQ 2nd 1249 (CAFC, 1987). Neither SS Pharmaceutical, Tsunoda, Yeh et al nor Lambelet disclose nutritional supplements which are not adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever, as claimed by Applicant. This absence from SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet of such nutritional supplements which are explicitly required by claims 26-30, 32-35 and 37-47 makes the rejection improper, In re Evanega.

SUPERIOR RESULTS

The statute does not require a patentable invention to be superior Demaco Corp v F Von Langsdorff Licensing Ltd. 7 USPQ2d 1222 (Fed. Cir 1988). Neither SS Pharmaceutical, Tsunoda, Yeh et al nor Lambelet disclose nutritional supplements which are not adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever, as claimed by Applicant. Applicant's claimed invention provides superior results to SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet by providing nutritional supplements which are not adapted to aid in or contribute to discomfort relieving functions of a discomfort reliever or to aid in or contribute to reducing side effects of the discomfort reliever. Accordingly, beyond the requirements of the statute, claims 26-30, 32-35 and 37-47 are patentable over SS Pharmaceutical in view of Tsunoda, Yeh et al and Lambelet..

SS PHARMACEUTICAL AND TSUNODA TEACH AWAY FROM THE INVENTION

Nutritional supplements which are not adapted to aid in or contribute to relieving discomfort, are taught away from by disclosure of Vitamin C for discomfort relief in SS Pharmaceutical and Tsunoda. Essentially, teaching away from the invention by the art, is a *per se* demonstration of *prima facie* nonobviousness, In Re Dow Chemical Co. 5 USPQ 2d 1529 (CAFC), 1988. SS Pharmaceutical and Tsunoda by teaching away from the claimed invention are *per se* demonstrations of *prima facie* nonobviousness of the claimed invention. Accordingly, SS Pharmaceutical and Tsunoda demonstrate the *prima facie* nonobviousness of claims 26-30, 32-35 and 37-47.

LACK ANY TEACHING FOR THE COMBINATION OF REFERENCES

A proper combination of references requires a teaching in the references to suggest the combination thereof, In re Semaker 702 F2d 989, 217 U.S.P.Q. 1 (CAFC, 1983). There is no teaching in SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet to suggest the combination thereof to provide Applicant's invention. Accordingly, the combination of SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet is improper, In re Sernaker.

THE COMBINATION OF REFERENCES IS A HINDSIGHT RECONSTRUCTION OF APPLICANT'S INVENTION

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine, 837 F2d 1071, 1075, 5 USPQ 2d 1598, 1600 (Fed. Cir. 1988). It is legal error to use the inventor's patent specification teaching of both a novel and nonobvious invention as though it were prior art in order to make claims appear to be obvious In re Pleuddemann, 901 F2d 823, 828, 15 USPQ 2d 1738, 1742 (Fed. Cir 1990). In constructing the final rejection of Examiner combines SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet without any teaching in the references for the

combination thereof. The combination of SS Pharmaceutical, Tsunoda, Yeh et al and Lambelet in the final rejection is legal error.

#### CONCLUSION

The claims are patentable over the nonanalogous prior art applied. The claims are patentable as, the prior art applied does not disclose the features or benefits of the claimed invention. The applied references teach away from the invention and lack any teaching for the combination thereof. The applied combination of references is based upon improper hindsight reconstruction of Appellant's invention.

Reversal of the Final Rejection and allowance of the claims is respectfully requested.

Respectfully submitted,



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